

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

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BOARD OF PATENT APPEALS
AND INTERFERENCES**

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KARL HENDERSON, JAMES DUKE BOND,
STACY BOROCZ, ANNE GILLMAN and KAMRAN MIR

Appeal No. 2002-1688
Application No. 09/321,387

ON BRIEF

Before JERRY SMITH, FLEMING and RUGGIERO, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 9-13 and 28-32, which are all of the claims pending in the present application. Claims 1-8 and 14-27 have been canceled. An amendment filed March 5, 2001 after final rejection was approved for entry by the Examiner.

The disclosed invention relates to a system and method for recording messages associated with a prepaid telephone calling

card. More particularly, a prepaid telephone calling card processing system, coupled to a data storage system which stores calling card and message data, is configured to receive a request to record a message during a service setup call over a telephone network. The system will receive requests for message playback and automatically playback the recorded message in response to an access call received over the telephone network.

Claim 9 is illustrative of the invention and reads as follows:

9. A method for recording at least one message associated with a prepaid telephone calling card, comprising:

storing data corresponding to the prepaid telephone calling card and the at least one message;

receiving, over a telephone network, a prepaid telephone calling card access code during a service setup call;

determining, based on the received access code, whether the prepaid telephone calling card comprises a first type of card;

if the prepaid telephone calling card comprises the first type of card, initiating the recording of the at least one message during the service setup call; and

if the prepaid telephone calling card does not comprise the first type of card, directing a caller associated with the service setup call to call a first telephone number.

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The Examiner relies on the following prior art:

Atkins et al. (Atkins)	5,487,107	Jan. 23, 1996
Moen	5,592,537	Jan. 07, 1997
Longo et al. (Longo)	5,912,956	Jun. 15, 1999 (filed Feb. 20, 1997)
Nabkel	5,963,626	Oct. 05, 1999 (filed Sep. 25, 1997)
Kamel	6,009,150	Dec. 28, 1999 (filed Nov. 16, 1998)

Claims 9-13 and 28-32 stand finally rejected under 35 U.S.C. § 103(a). As evidence of obviousness, the Examiner offers Longo alone with respect to claims 28 and 29, adds Atkins to Longo with respect to claims 9-12, adds Nabkel to Longo with respect to claim 30, and adds Moen to Longo with respect to claims 31 and 32. With respect to claim 13, Kamel is added to the combination of Longo and Atkins.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief (Paper No. 13) and Answer (Paper No. 14) for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Brief along

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with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 9-13 and 28-32. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.,

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776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to independent claim 9, Appellants' arguments in response to the obviousness rejection initially assert a failure by the Examiner to establish a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by the applied prior art references. After reviewing the applied Longo and Atkins references in light of the arguments of record, we are in general agreement with Appellants' position as stated in the Brief.

Our interpretation of the disclosure of Longo coincides with that of Appellants, i.e., we find no disclosure of any guidance or direction for a caller to call a telephone number in response to a determination that a prepaid telephone card is a first card type. In our view, the Examiner has unreasonably interpreted the language of claim 9 as merely requiring a direction to a caller to call a telephone number (a customer service number in the example

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proffered by the Examiner) in the case of problems in authenticating the use of a prepaid telephone card.

We further agree with Appellants (Brief, pages 8 and 9) that even assuming, arguendo, that the disclosure of Longo could be interpreted as describing a determination of a first card type, the Examiner has failed to establish proper motivation for combining the customer service teachings of Atkins with Longo to arrive at the claimed invention. In our view, any authentication problems associated with the charging of a telephone call to a credit card such as described in Atkins, would not exist in a system such as disclosed in Longo in which the costs associated with telephone services are prepaid and manifested in the issuance of the telephone card. Given the disparate nature of the Longo and Atkins references, it is our opinion that any suggestion to combine them could come only from Appellants' own disclosure and not from any teachings in the references themselves.

In view of the above discussion, since the Examiner has not established a prima facie case of obviousness, the 35 U.S.C. § 103(a) rejection of independent claim 9, as well as claims 10-12 dependent thereon, is not sustained.

We also do not sustain the Examiner's 35 U.S.C. § 103(a) rejection of dependent claim 13 in which Kamel is added to the

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proposed combination of Longo and Atkins. We have reviewed the Kamel reference, applied by the Examiner to address the automatic playback feature set forth in dependent claim 13, and find nothing which would overcome the innate deficiencies of Longo and Atkins discussed supra.

Turning to a consideration of the Examiner's 35 U.S.C. § 103(a) rejection of independent claims 28 and 29 based on Longo alone, we do not sustain the rejection of these claims as well. The language of claims 28 and 29 requires, on the determination of a prepaid card being an audio message type card or an audio message being stored, the initiation of a call in response to a call access request (claim 28) or the initiation of playback of an audio message unaffiliated with the prepaid telephone card (claim 29).

In addressing the language of claims 28 and 29, the Examiner asserts (Answer, pages 7-9 and 16-18) the well known aspects of prepaid telephone cards which are used solely for making telephone calls as opposed to prepaid telephone cards which can access special services such as described in Longo. While we do not dispute the Examiner's assertions that such generalized restricted use telephone cards may exist, we fail to see the relevance of the factual existence of such cards in relation to the issue of obviousness with respect to the specific limitations in claims 28

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and 29. As pointed out by Appellants (Brief, pages 12-14), claims 28 and 29 require either the initiation of message playback or initiation of a call in response to the determination of a specific condition, i.e., either the telephone card is not a message card or a message has not been stored. To whatever extent the Examiner (Answer, pages 16-18) is interpreting the claim language to require only the activation of a "call connect or call set up" as in the conventional use of a prepaid telephone card, we find no basis for the Examiner interpreting the claim language in this manner.

We also do not sustain the Examiner's obviousness rejection of independent claim 30 in which Nabkel is added to the combination of Longo and Atkins to address the particular claimed message deletion feature. Initially, we agree with Appellants (Brief, page 15) that, the Examiner's statements notwithstanding, deleting a message after determining how many times it has been played is not equivalent to deleting a message after everyone on a list of people has heard the message as in Nabkel. Further, we fail to see why a skilled artisan would seek to modify Longo, which discloses an identification tag calling card with message storing capability to aid in identifying lost persons or items, with Nabkel which discloses limiting the amount of stored message playback.

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Lastly, the Examiner's 35 U.S.C. § 103(a) rejection of independent claims 31 and 32, in which Moen is added to the combination of Longo and Atkins, is also not sustained. While the Examiner suggests (Answer, page 11) that the skilled artisan would have found it obvious to record any desired type of message in the system of Longo as modified by Atkins, such as the particularly claimed "purchase preference" message, the record before us is totally devoid of any evidence to support such a position. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F. 2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The Examiner must not only make requisite findings, based on the evidence of record, but must also explain the reasoning by which the findings are deemed to support the asserted conclusion. See In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002).

Further, it is our view that the Moen reference, cited by the Examiner as disclosing the recording of "purchase preference" messages for subsequent playback, stands for nothing more than that such systems exist in the prior art. We find no suggestion in the Moen reference or elsewhere, outside of Appellants' own disclosure,

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for combining Moen with Longo and Atkins to thereby arrive at the specific combination set forth in claims 31 and 32.

In conclusion, we have not sustained the Examiner's 35 U.S.C. § 103(a) rejections of any of the claims on appeal. Accordingly, the decision of the Examiner rejecting claims 9-13 and 28-32 is reversed.

REVERSED

Jerry Smith
JERRY SMITH

JERRY SMITH
Administrative Patent Judge


MICHAEL R. FLEMING

MICHAEL R. FLEMING
Administrative Patent Judge

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